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09/354,802	07/16/1999	RICHARD MARC LIBMAN	23651.1300	5598

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EXAMINER

AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

2164

DATE MAILED: 04/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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PRG

# Office Action Summary

Application No. <u>09/354802</u>	Applicant(s) <u>Cibola</u>
Examiner <u>Akers, G</u>	Group Art Unit <u>2154</u>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7/16/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-50 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).
- \*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

1. Claims 1-50 have been examined.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Independent claims 1-3,36,38,43,47,49 are rejected under 35 USC 102(e) as anticipated by Tobin(US Pat. No: 6,141,666).
4. As per claim 1 Tobin teaches a method for automatically preparing a customized reply to each response communication from a plurality of clients(Abstract)(col 2 line 57-col 3 line 62)(col 5 line 1-col 6 line 19) where each response labeled to correspond to a labeled communication set to each of the plurality of clients(Fig 8)(col 8 line 49-54) where the method comprises receiving a plurality of responses where each response comprises a unique label to identify each response as coming from a particular client(col 9 line 52-col 10 line 7) and each response comprises a non purchase response option information (Fig 7)(col 8 lines 25-40)(col 7 lines 12-31)(Fig 1C/114)(Fig 7/114) and inputting the response option information and corresponding client identification into an automated reply generation system(Fig 7/708) and preparing a reply specific to each response of the plurality of responses using the automated reply generation system where

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each reply comprises a label corresponding to the unique label of its corresponding response(Fig 7/115) and delivering prepared replies to the clients.

5. As per claims 2,3,36,38,43,47,49 Tobin teaches a system for automatically preparing customized communications each of a plurality of clients where the communications present client response options including non purchase options(Abstract)(Fig 7/114)(col 8 lines 25-40) and replying to non purchase options from clients with customized replies where the method comprises using decision information to automatically select variable information about each client and inserting the client information into the client communication which includes client response options(Fig 7/102) and appending each client communication to a separate host communication to form a plurality of combine communications where each of the combined communications comprises a client identifying label(Fig 7/708) and where delivering each combine communication to a respective one of the plurality of clients(Fig 8) and receiving a plurality of responses where each response comprises an identifying label and response option information(Fig 11C/114)(Fig 18/1800) and inputting the response option information into each of the responses in a system for generating replies(Fig 12/115) and preparing a reply to each of the responses where each reply is directed to response option information and each reply comprises an identifying label and(Fig 18) delivering the replies to the appropriate client(Fig 12/708).

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Dependent claims 4-35,37,39-42,44-46,48,50 are rejected under 35 USC 103(a) as unpatentable over Tobin(US Pat. No:6,141,666) in view of Atkins(US Pat. No: 5,852,811).

8. As per claims 4-35,37,39-42,44-46,48,50 Tobin teaches a method for automatically preparing a customized reply to each response communication from a plurality of clients(Abstract)(col 2 line 57-col 3 line 62)(col 5 line 1-col 6 line 19) where each response labeled to correspond to a labeled communication set to each of the plurality of clients(Fig 8)(col 8 line 49-54) where the method comprises receiving a plurality of responses where each response comprises a unique label to identify each response as coming from a particular client(col 9 line 52-col 10 line 7). Tobin fails to teach the method of claim 1 wherein the labeled computer communication comprises information about a financial product utilizing the internet. Atkins teaches this(Abstract)(Fig 3)(col 3 line 6-col 5 line 60)(col 6 lines 53-59)(col 20 line 24-col 23 line 51)(Table 14)(col 24 lines 13-34)(col 34 line 28-col 36 line 45)(Fig 8a/8b/8c)(col 42 line 21-col 44 line 48). It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Atkins to teach the above. The motivation to combine is to provide a method to meet the wide variety of individual financial resources and attitudes toward financial

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investments and risk and to produce financial products tailored and customized to the current needs of individuals and be flexible to accommodate future variations in their requirements as enunciated by Atkins(col 2 lines 49-53).

***Double Patenting***

9. Claims 1-50 are rejected under the judicially created doctrine of double patenting over claims 1-56 of U. S. Patent No. 5,987,434 to Libman since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: marketing and sales of customized financial products.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Conclusion***

10. THIS ACTION IS MADE NON-FINAL.

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Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through

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Friday at 703-306-5844. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703)-308-6296 or 6306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3900.

GRA

  
April 18, 2002